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Amendment
Attorney Docket No. S63.2R-9493-US02

Remarks

This Amendment is in response to the Office Action dated **September 11, 2003**. Claims 1 – 15 are pending in this application. The Examiner withdrew claims 4, 5, 7 and 8 from consideration. The Examiner rejected claims 1 – 3, 6 and 13 under 35 USC § 102(e) over Hanson (US 6607552); rejected claims 9 – 11, 14 and 15 under 35 USC § 103(a) over Shull et al. (US 6143022) in view of Hanson; and rejected claim 12 under 35 USC § 103(a) over Yang (US 6379382) in view of Hanson.

By this Amendment, claim 1 is amended and claims 9, 10, 12 and 13 are rewritten in independent form. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Restriction Requirement

The Office Action mailed June 2, 2003 (Paper No. 9) required election of one of four species of the invention. Species IV further contained subspecies i and subspecies ii.

Applicants provisionally elected with traverse species II (claims 1 – 3 and 6 – 15) in the Response To Restriction Requirement With Traverse filed July 2, 2003. The Examiner treated Applicants' election as an election without traverse "because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement."

Applicants assert that the Response To Restriction Requirement With Traverse filed July 2, 2003 specifically asserted that withdrawn claims 4 and 5 are so related to the elected claims of species II that inclusion of claims 4 and 5 would not result in an unduly burdensome prior art search. Further, attention was drawn to claim 3, which was listed as the only non-generic claim readable on species I and also listed as the only non-generic claim readable on species II. Thus, Applicants questioned the appropriateness of the restriction between species I and species II, and further questioned how claim 3 could be characterized as being distinct from itself.

The Examiner contacted one of the Applicants' attorneys by telephone and required further election of subspecies i or subspecies ii. Applicants' attorney provisionally elected subspecies i in order to be fully responsive. Applicants did not originally include an election of a subspecies in the Response To Restriction Requirement With Traverse filed July 2,

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2003 because it was not clear from the text of the restriction requirement that subspecies i and subspecies ii were intended to apply to each of the four enumerated species.

The Examiner alleges in the currently outstanding Office Action that the subspecies election was made without traverse. However, Applicants assert that the subspecies election was made in furtherance of Applicants' provisional election with traverse of species II, and thus constituted an election with traverse.

Applicants provisionally elect with traverse species II, subspecies i (claims 1 – 3, 6 and 9 – 15 readable thereon). Applicants reserve the right to prosecute the subject matter of all withdrawn claims, as originally filed, in a subsequent patent application claiming priority to the immediate application.

Applicants assert that although the Examiner has alleged that the application contains claims directed to four patentably distinct species, the Examiner has not shown any of the pending claims to either: a) have a separate classification; b) have a separate status in the art; or c) require a different field of search than any other claims pending in the application. Thus, Applicants assert that the Examiner has not provided appropriate grounds for imposing the restriction requirement.

Applicants further assert that the application was filed with only one independent claim, and that even the Examiner has indicated that nine of the fifteen claims filed, specifically claims 1, 2 and 9 – 15, are generic.

Therefore, Applicants respectfully request withdrawal of the restriction requirement.

Claim Rejections – 35 USC § 102

The Office Action rejects, under 35 USC § 102, claims 1 – 3, 6 and 13 over Hanson (US 6607552).

Claim 1 has been amended to recite, "...at least a portion of the membrane disposed beneath at least a portion of the at least one sleeve." Support for the amendment may be found at least in Figure 5 and in the specification at page 10, lines 10 – 11.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," *Verdegaal Bros. v.*

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Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Hanson discloses a sheath 33 and a sleeve 10, each having a portion disposed about a portion of a stent 32. As shown in Figure 8, the sleeve 10 overlays the distal stent end 48 while the sheath 33 overlays the proximal end 50. See column 4, lines 13 – 15.

Hanson does not disclose or suggest a configuration wherein a portion of a membrane is disposed beneath a portion of a sleeve, as recited in independent claim 1. Therefore, Hanson does not anticipate claim 1. Claims 2, 3, 6 and 13 depend from claim 1 and therefore are not anticipated for at least the reasons discussed above. Accordingly, Applicants request withdrawal of the rejections under 35 USC § 102.

Claim Rejections – 35 USC § 103

The Office Action rejects, under 35 USC § 103, claims 9 – 11, 14 and 15 over Shull et al. (US 6143022) in view of Hanson and claim 12 over Yang (US 6379382) in view of Hanson. These rejections are respectfully traversed.

The following is a quotation of 35 USC § 103(c):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Both the subject matter of Hanson and the claimed invention were subject to an obligation of assignment to Scimed Life Systems, Inc. at the time the invention was made. Both Hanson and the present application are now assigned to Scimed Life Systems, Inc.

Thus, Hanson is not available as prior art under 35 USC § 103, and the rejections under 35 USC § 103 are rendered moot.

Accordingly, Applicants request the withdrawal of the rejections under 35 USC § 103.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt

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allowance of claims 1 – 15 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: 12/10, 2003

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